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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/608,416

06/30/2003

Alfred Korber

45384

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11/15/2006

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EXAMINER

ZHANG, NANCY L

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/608,416

Applicant(s)

KORBER, ALFRED

Examiner

Nancy L. Zhang

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) 7,10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1 sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's election with traverse of Group I, lactic acid menthyl ester compacts along with 1-lactic acid 1-menthyl ester as the elected species, in the reply filed on Sept. 28, 2006, is acknowledged. The traversal is on the grounds that there would be no burden in searching all of the claims in Group I and Group III. This is not found persuasive because the inventions as claimed in Group I and III are distinctive for reasons of record. Furthermore, the search of the entire groups in the non-patent literature (a significant part of a thorough examination) would be burdensome. The requirement is still deemed proper and is therefore made FINAL.

Claims 7, 10 and 11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to the non-elected invention.

Claims 1 and 4-6 are examined.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Regarding claim 1, the expression "(m/m)" renders the claim indefinite because it is not clear and concise what the limitation is.

For examination purposes, "m/m" is interpreted as "w/w" weight percentage for the recited 95% in claim 1.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 4-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kuhn et al. (US Patent 5,783,725, issue date: Jul. 21, 1998).

Claims 1 and 4-6 read on a product of lactic acid menthyl ester compact wherein the lactic acid menthyl ester content in the compact is at least 95% (w/w). Further

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limitations include "said compact is formed by a process comprising compression" (claim 5) and "said compact exhibiting the form of spheres, cubes, cuboids, cushions, cylinders, tablets, pellets or briquettes" (claim 6).

Kuhn et al. teach a stabilized lactic acid menthyl ester product where the content of lactic acid menthyl ester is 99.7%, parts by weight (column 2, lines 41-42) which meets the limitation of at least 95% (w/w).

The content of 99.7% of lactic acid menthyl ester in the product disclosed by Kuhn et al. is identical to the content of lactic acid menthyl ester as claimed in the instant application. It is noted that the word "compact" is defined in the dictionary as "closely and firmly united or packed together" (see WEBSTER'S dictionary). Since the crystal slurry of lactic acid menthyl ester as disclosed by Kuhn et al. is filtered off and dried in air (column 2, lines 39-40) to result in a product containing 99.7% of lactic acid menthyl ester, the content of lactic acid menthyl ester in the product is closely and firmly united together in the product. Thus, it is clear that the product as claimed is anticipated.

With respect to claim 6, it is known when precipitated crystals are filtered and dried, pellets would usually form. Since the crystal slurry of lactic acid menthyl ester as disclosed by Kuhn et al. is filtered off and dried in air (column 2, lines 39-40), the product of lactic acid menthyl ester is in form of pellets.

With respect to claim 5, since the product of lactic acid menthyl ester disclosed by Kuhn et al. is identical to the product of lactic acid menthyl ester as claimed in the

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instant application, the process of producing the product does not further limit the product because a product is not dependent upon the manner in which it is produced.

As discussed above, a product of lactic acid menthyl ester as claimed in the instant application is anticipated by Kuhn et al.'s teaching.

In alternative, even if the product of lactic acid menthyl ester by Kuhn et al. differs from the lactic acid menthyl ester compacts, the preparation of lactic acid menthyl ester into compacts is well within the skill of an artisan. Since compact products have storage and transport advantages, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to prepare lactic acid menthyl ester into a compact form to result in the product as claimed in the instant invention with a reasonable expectation of success.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nancy L. Zhang whose telephone number is (571)-272-8270. The examiner can normally be reached on Mon.- Fri. 8:30am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on (571)-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

nlz 11/8/06

NLZ

BRIAN-YONG S. KWON
PRIMARY EXAMINER

